

REMARKS

The Examiner has maintained the previous rejection of all claims under 35 U.S.C. §103 as being unpatentable primarily over Iacovelli (U.S. Patent No. 5, 350,391) in view of Gain (U.S. Patent No. 3,840,015). Applicant respectfully requests that the Examiner reconsider this rejection in view of the below Remarks.

The present invention is directed to an endoscopic instrument having a fluorescent marking on a distal end thereof, which fluorescent marking has a fluorescent excitation range which lies within a fluorescent excitation range of surrounding tissue (whether autofluorescent or fluorescent by way of a photosensitizer). The present invention also includes a light source having a wavelength selected so as to excite both the fluorescent marking and the fluorescent surrounding tissue. This allows for both the fluorescent marking and the fluorescent surrounding tissue to be caused to fluoresce with a single light source.

Applicant respectfully submits that this required feature of all claims is not disclosed, taught or suggested by any of the prior art cited by the Examiner, and in fact is taught away from therein.

Iacovelli is directed to a surgical instrument which includes a plurality of colored stripes printed on the surface of the instrument in order to assist the

surgeon in determining the depth of cuts being made. While Iacovelli does disclose that the stripes may comprise a photoluminescent coating, Iacovelli specifically teaches that: "For optimal visibility, the colors of the stripes should contrast with the colors of tissue and fluids in the human body." The reason for this is that the entire purpose of the stripes is for the surgeon to be able to readily and quickly see the stripes against the background tissue in order to gauge the depth of cut.

As such, not only does Iacovelli not disclose, teach or suggest that the markings have a fluorescent excitation range which lies within a fluorescent excitation range of surrounding tissue and that both the markings and the tissue be excited by a single light source at the same time, but Iacovelli explicitly teaches away from this feature by expressly stating that the stripes should contrast with the surrounding tissue. If Iacovelli were modified to arrive at the present invention (with the markings and the tissue having overlapping excitation ranges), they would not contrast. This would be directly contrary and repugnant to the teachings of Iacovelli, and one skilled in the art faced with Iacovelli would clearly not make such a modification.

Gain is directed to a surgical device which is coated or impregnated with a photoluminescent substance. When the device is used during surgery, an excitation energy appropriate for the photoluminescent substance is applied to the

surgical site, causing the device to luminesce. Similar to Iacovelli, however, Gain does not disclose, teach or suggest in any way that the photoluminescent substance have a fluorescent excitation range which lies within a fluorescent excitation range of surrounding tissue and/or that both the photoluminescent substance and the tissue be excited by a single light source at the same time.

Applicant understands the Examiner to be asserting in Paragraph 6 of the outstanding Office Action mailed on February 11, 2004 that Gain may be capable of being operated in the claimed manner, in that the surgeon may inadvertently choose the photoluminescent substance such that its fluorescent excitation range inadvertently overlaps with some fluorescent excitation range of tissue autofluorescence, and then that the surgeon may inadvertently choose a light source which only emits light of specific wavelength ranges matching excitation ranges of both the photoluminescent substance and the autofluorescent tissue in order to arrive at the claimed invention.

However, even if such an assertion is true (which Applicant does in no way agree with), Applicant respectfully submits that the point is moot. The mere fact that a reference can be modified to arrive at the claimed invention does not render the claimed invention obvious unless the prior art also suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In the present case, the Examiner is relying on a series of coincidences and

inadvertent choices as a basis for an obvious rejection, rather than on any teaching or suggestions in the prior art. Applicant respectfully submits that such is not proper.

For the foregoing reasons, Applicant respectfully submits that all pending claims, namely Claims 1-44, are patentable over the references of record, and earnestly solicits allowance of the same.

Respectfully submitted,



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